

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HENRICUS ANTONIUS WILHELMUS VAN GESTEL, and
NATHALIE DOROTHEE PIETERNEL LEURS

Appeal 2007-0608
Application 09/738,647
Technology Center 2600

Decided: April 17, 2007

Before JOSEPH F. RUGGIERO, LANCE LEONARD BARRY, and
JEAN R. HOMERE, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Examiner's Final Rejection of claims 1, 3 through 6 and 8 through 16. We have jurisdiction under 35 U.S.C. § 6(b) to decide this appeal.

Appellants invented a method, apparatus and system for recognizing a user's handwritten note to generate a computer-formatted handwritten note that conveys the content of the user's note in a style that matches the style of the user's handwriting. Particularly, the invention compares the user's handwritten characters with each of a plurality of predefined fonts of corresponding characters. Then, the invention selects and displays the font for the characters that most closely matches the user's handwritten characters. (Specification 1 and 2).

Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. Apparatus for reproducing handwritten input, comprising:
 - an input device for inputting a plurality of handwritten characters,
 - a recognition unit for recognizing the plurality of handwritten characters,
 - a selection unit for selecting a display font from among a plurality of fonts, and
 - a display unit for displaying one or more display characters corresponding to respective ones of the recognized handwritten characters, using the display font,

wherein the selection unit selects the display font based on a comparison of one or more of the plurality of handwritten characters with one or more corresponding characters in each of the plurality of fonts.

In rejecting the claims on appeal, the Examiner relied upon the following prior art:

Shojima	US 5,592,565	Jan. 7, 1997
Cok	US 6,298,154	Oct. 2, 2001

The Examiner rejected the claims on appeal as follows:

- A. Claims 1, 6 and 8 through 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shojima.
- B. Claims 3¹ through 5 and 13 through 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shojima and Cok.

Appellants contend² that Shojima, taken alone or in combination with Cok, does not render claims 1, 4 through 6 and 9 through 12 unpatentable. Particularly, Appellants contend that Shojima does not fairly teach or suggest selecting a font by comparing a user's handwritten characters to characters of a plurality of fonts to determine a font for displaying the user's recognized characters, as recited in representative claim 1. (Br. 6 and 7; Reply Br. 2). The Examiner, in contrast, contends that Shojima teaches the cited limitations of representative claim 1 as comparing an input handwritten character data with registered data dictionary to recognize a most similar pattern, as well as to select and display a font corresponding to the recognized character pattern. (Answer 3 and 7). The Examiner therefore concludes that Shojima renders representative claim 1 unpatentable.

Appellants further contend that Shojima, taken alone or in combination with Cok, does not render claims 3, 8 and 13 through 16 unpatentable since it does not teach a creation unit for creating a new font on the basis of the plurality of handwritten characters. (Br. 8). In response, the Examiner

¹ We note that claim 3 improperly depends upon higher numbered claim 13.

² This decision considers only those arguments that Appellants submitted in the Appeal and Reply Briefs. Arguments that Appellants could have made but chose not to make in the Briefs are deemed to have been waived. See 37 C.F.R. § 41.37(c)(1) (vii)(eff. Sept. 13, 2004). See also *In re Watts*, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

contends that the combination of Shojima and Cok teaches the cited claimed limitation as a mechanism for improving the user's input handwriting by combining a digitized picture of said handwriting with a corresponding normative handwritten font. Therefore, the Examiner concludes that it would have been obvious to combine Shojima and Cok to yield the invention as recited in claims 3, 8³ and 13 through 16. (Answer 6 and 8).

We affirm in part.

ISSUES

The *pivotal* issues in the appeal before us are as follows:

- (1) Have Appellants shown that the Examiner has failed to establish that one of ordinary skill in the art, at time of the present invention, would have found that the disclosure of Shojima renders the claimed invention unpatentable under 35 U.S.C. § 103(a), when Shojima teaches comparing an input handwritten character data with a registered data dictionary to recognize a most similar pattern, as well as to select and display a font corresponding to the recognized character pattern?
- (2) Have Appellants shown that the Examiner has failed to establish that one of ordinary skill in the art, at the time of the present invention, would have found that the combined disclosures of Shojima and Cok render the claimed invention unpatentable under 35 U.S.C. § 103(a) when Cok teaches a mechanism for improving the handwriting sample of a user?

³ We note that the Examiner rejected claim 8 over Shojima alone. We will enter infra a new ground of rejection against claim 8 as being unpatentable over Shojima and Cok.

FINDINGS OF FACT

The following findings of fact are supported by a preponderance of the evidence.

The invention

1. Appellants invented a method, apparatus and system for recognizing a user's handwritten note to generate a computer-formatted handwritten note that conveys the content of user's note in a style that matches the style of the user's handwriting. (Specification 1).
2. As depicted in figure 1, a user inputs a handwriting sample via input device 102. (Specification 3).
3. A recognition unit (106) analyzes the input handwritten sample, and tries to recognize the characters in the handwritten sample. (Specification 4).
4. A selection unit (108) compares the user's handwritten characters with each of a plurality of predefined fonts (stored in font storage 110) of corresponding characters to select the font that most closely matches the user's handwritten characters. (Specification 4).
5. A display unit (114) displays the selected font (Specification 4).
6. As depicted in figures 3 and 4, a creation unit (112) can also be used to create a new font based on the plurality of handwritten input characters. (Specification 4 and 7).

The Prior Art Relied upon

7. Shojima discloses a handwritten character recognition apparatus that uses a personal dictionary preparation function to recognize a plurality of handwritten input characters. (col. 1, ll. 12-18).

8. As depicted in figure 1, the disclosed character recognition apparatus contains a stroke processing unit (6), including a character recognition means, standard dictionary (7) for recognizing characters, a personal dictionary (B5) for comparing entered characters, and a display unit(2, 8) for displaying recognized characters. (col. 3, ll. 20-48).

9. After handwritten characters are entered or registered with the character recognition apparatus, the handwritten characters are recognized, and any of KANA to KANJI characters corresponding to the recognized handwritten characters are selected to be displayed. (col. 4, ll. 50-67).

10. The entered handwritten characters are matched against pre-registered fonts of corresponding characters to select and display a font suitable for the recognized handwritten character pattern. (Abstract and col. 5, ll. 30-61).

11. Cok discloses a method for improving the appearance of a personal handwritten sample by combining the digital image of the sample with a digital image of the sample written in normative handwriting font obtained from a font memory (26) (col. 4, ll. 53-57).

PRINCIPLES OF LAW

OBVIOUSNESS

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). See also *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of

ordinary skill in the art suggests the claimed subject matter. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. See also *Piasecki*, 745 F.2d at 1472, 223 USPQ at 788. Thus, the Examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the Examiner's conclusion.

ANALYSIS-NEW GROUND OF REJECTION

A. 35 U.S.C. § 103(a) REJECTION

As set forth above, representative claim 1 requires a selection unit for selecting a display font from among a plurality of fonts based on the comparison of one or more of the plurality of handwritten characters with one or more corresponding characters in each of the plurality of fonts. As detailed in the findings of fact section above, we have found that Shojima discloses selecting and displaying from among a plurality of fonts a font having characters that correspond to the characters of a handwritten input sample. (finding of fact 9). We have also found that Shojima teaches that the selection and display of the font is based upon a match that results from comparing the font characters with the handwritten sample characters. (findings of fact 9 and 10). In light of these findings, it is our view that Shojima teaches the limitation of selecting and displaying a font based on the character comparison, as recited in claim 1. It follows that the Examiner did not err in rejecting representative claim 1 as being unpatentable over Shojima. It follows for the same reasons that the Examiner did not err in

rejecting claims 4 through 6 and 9 through 12 as being unpatentable over Shojima, taken alone or in combination with Cok.

Now, we turn to the rejection of claims 3, 8 and 13 through 16 as being unpatentable Shojima, taken alone or in combination with Cok. We note that each of the cited claims requires a creation unit for creating a new font based on the plurality of handwritten characters. As detailed in the findings of fact above, we have found that Cok discloses improving the appearance of a handwriting sample by combining digital images of the sample including a normative image of the sample obtained from a font storage. (finding of fact 11). In light of this finding, it is our view that one of ordinary skill in the art would have aptly realized that the improved appearance of the handwriting sample resulting from combining the digital images of the sample amounts to creating a new font for the sample. It is further our view that the ordinarily skilled artisan would have readily recognized that such a new font is based upon the original handwritten sample since it is a product of the digital images of the original sample. Therefore, it follows that the Examiner did not err in rejecting representative claims 3 and 13 through 16 as being unpatentable over the combination of Shojima and Cok.

B. NEW GROUND OF REJECTION UNDER 37 C.F.R. § 41.50

We find that claim 8 requires a creation unit for creating a new font based on the plurality of handwritten characters. We find that Shojima does not teach or suggest that limitation. It follows that the Examiner erred in rejecting claim 8 as being unpatentable over Shojima. We have found, however, that Cok teaches that limitation as discussed in the preceding

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section. Accordingly, we impose the new ground of rejection under 37 C.F.R. § 41.50(b).

Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Shojima in view of Cok.

Claim 8 is unpatentable over the combination of Shojima and Cok for the same reasons set forth in the discussion of claims 3, 13 through 16 above.

CONCLUSION OF LAW

On the record before us, Appellants have not shown that the Examiner has failed to establish that Shojima, taken alone or in combination with Cok, renders claims 1, 3 through 6 and 9 through 16 unpatentable under 35 U.S.C. § 103(a). However, Appellants have shown that the Examiner has failed to establish that Shojima renders claim 8 unpatentable under 35 U.S.C. § 103(a).

DECISION

We have affirmed the Examiner's decision to reject claims 1, 3 through 6, and 9 through 16 under 35 U.S.C. § 103(a). We, however, have reversed the Examiner's decision rejecting claim 8 under 35 U.S.C. § 103(a).

Further, we have entered a new ground of rejection against claim 8 under 37 C.F.R. § 41.50(b).

37 C.F.R. § 41.50(b) provides that, “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

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37 C.F.R. § 41.50(b) also provides that the Appellants, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings as to the rejected claims:

- (1) Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner ...
- (2) Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record ...

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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